

REMARKS / DISCUSSION OF ISSUES

Claims 1-18 are pending in the application. Claim 1 is the independent claim.

I. Rejections under 35 U.S.C. § 102

Claims 1-7 and 10-15 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by *Schick* (U.S. Patent Application Publication 20060261470; now U.S. Patent 7,505,268). Claims 8-9 and 16-18 were rejected in the alternative under 35 U.S.C. § 102(b) in as allegedly being anticipated by *Schick*, or in the alternative under 35 U.S.C. § 103(a) as allegedly being obvious in view of *Schick*. Applicants respectfully submit that in view of the priority date and publication date of the present application and *Schick*, respectively, a rejection under 35 U.S.C. § 102(b) is improper.

For at least the reasons set forth below, Applicants respectfully submit that all claims are patentable over the applied art.

At the outset Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim.¹ Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference.² Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice.³ For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.⁴

a. Claim 1

Claim 1 recites:

A thermally and electrically conductive apparatus to which one or more electronic devices can be operatively connected, the apparatus comprising:
a) a thermally conductive element in thermal contact with the one or more electronic devices; and

¹ See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983).

² See, e.g., *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990).

³ See, e.g., *Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992).

⁴ See, e.g., *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

b) a multilayer coating system comprising three or more layers, said three or more layers being a sequence of electrically insulating and electrically conductive layers integrally formed on a portion of the thermally conductive element, said electrically conductive layers providing one or more paths for supplying electric current to the one or more electronic devices.

In a representative embodiment described in connection with Fig. 1a of the filed application, a multilayer coating system comprising alternating electrically conductive 103 and electrically insulating layers 102, 104 integrally formed on a portion of the thermally conductive element 101 (kindly refer to paragraph [0043] and Fig. 1a of the filed application for details of this representative embodiment).

Applicants respectfully submit that the applied art fails to disclose at least the featured multilayered coating system comprising three or more layers integrally formed on a portion of the thermally conductive element as specifically recited in claim 1. In rejecting claim 1, the Office Action directs Applicants to Fig. 4 of *Schick*, and specifically to paragraphs [0040], [0048] and [0050] for the alleged disclosure of a multilayered coating system set (see page 2 of the Office Action). Applicants respectfully submit that there is no disclosure of a multilayer coating system as specifically recited in claim 1. Notably, paragraph [0040] of *Schick* describes that the evaporator portion (e.g., evaporator portion 416) can be **coated with thermally conductive material or a non-thermally conductive dielectric material** that can be **patterned with electrical traces**. Thus, there is no disclosure of a multilayer coating system including three or more layers in the sequence specifically recited in claim 1, but rather a dielectric layer with patterned electrical traces.

Paragraphs [0048] and [0049] of *Schick* describe the materials that can be used as the substrate of the housing (e.g., housing 410). Notably, these materials are thermally conductive materials. Finally, paragraph [0050] describes how the substrate can be made of a metal with thermally conductive properties. Paragraph [0050] does describe that the substrate may be coated with a dielectric for electrical isolation of the light-emitting elements; and that electrical traces can be deposited on the dielectric to allow electrical conductivity. Applicants again respectfully submit that there is no disclosure of the multilayer coating system comprising three or more layers in the sequence, as specifically set forth in claim 1

Furthermore, the Office Action again relies on the evaporator portion 416 of *Schick* for the alleged disclosure of the thermally conductive element (See page 2 of the Office Action). Assuming *arguendo* but not conceding that the evaporator portion 416 can be so relied upon, Applicants note that the substrate and the housing (e.g., 410 described in paragraph [0050] of *Schick*) are also seemingly substituted for the alleged teachings of the thermally conductive element in the rejection. To this end, at pages 2 and 3 the Office Action directs Applicants to paragraphs [0040], [0048] and [0050] for the alleged disclosure of a multilayer coating system and asserts (with emphasis in original):

“(...thermally conductive element is covered with dielectric—Detailed Description 0040,0048 and 0050, where the housing comprises a substrate comprising a thermally conductive portion, and wherein electrical traces are deposited on dielectric coating.)”

Applicants respectfully submit that two different elements, the evaporator portion 416 and the housing 410, are both seemingly relied upon for the alleged disclosure of the thermally conductive element. Applicants again respectfully submit that the two different elements disclosed in the applied art cannot be properly relied upon for the teachings of one element of a claim. This is illogical and wholly improper.

For at least the reasons set forth above, Applicants respectfully submit that the applied art fails to disclose at least one feature of claim 1. Therefore, Applicants respectfully submit that a prima facie case of anticipation has not been established and claim 1 is patentable over *Schick*. Furthermore, claims 2-7 and 10-15, which depend immediately or ultimately from claim 1, are patentable for at least the same reasons and in view of their additionally recited subject matter.

b. General Comments on Rejections of Dependent Claims

Since each of the dependent claims depends from a base claim that is believed to be in condition for allowance, Applicant believes that it is unnecessary at this time to argue the allowability of each of the dependent claims individually. Applicant does not, however, necessarily concur with the interpretation of any dependent claim as set forth in the Office Action, nor does Applicant concur that the basis for the rejection of any dependent claim is proper. Therefore, Applicant reserves the right to specifically address the patentability of the dependent claims in the future, if deemed necessary.

II. Rejections under 35 U.S.C. § 103(a)

The rejection of claims 8-9 and 16-18 in the alternative under 35 U.S.C. § 103(a) has been considered. While Applicants in no way concur that the rejection is proper, claims 8, 9 and 16-18 depend from claim 1 immediately or ultimately, and are patentable for at least the reasons set forth above and in view of their additionally recited subject matter.

Conclusion

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.

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